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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,678	10/29/2003	Roger S. Kerr	81407ANAB	5036

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EXAMINER

LORENZO, JERRY A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,678

Applicant(s)

KERR, ROGER S.

Examiner

Jerry A. Lorengo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/29/2003</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

(1)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "said thermal print layer sheet" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, it has been assumed that claim 5 is drawn to the thickness of the second thermal print layer.

(2)

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7 of copending Application No. 10/696,117. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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Claims 1-7 are directed to the same invention as that of claims 1-7 of commonly assigned Application Serial No. 10/696,117. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

(3)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 11 and 12 of U.S. Patent No. 6,620,489 to Kerr. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the laminate of applicant claim 1 and that set forth in claim 1 of U.S. Patent No. 6,620,489, assuming formation in the step-wise manner as written, both consist of, in order, a first thermal print layer, an image, and second thermal print layer. Although the second support layer set forth in claim 1 of U.S. Patent No. 6,620,489 is subsequently removed in step (d), the two laminates are the same in fundamental constitution per steps (a) to (c).

(4)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-7 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. As set forth in section (2), above, the instant invention set forth in applicant claims 1-7 embodies the same invention as set forth in claims 1-7 of commonly assigned Application Serial No. 10/696,117. Although both applications have a common assignee, they also have different inventive entities. As such, an issue of priority under 35 U.S.C. 102(f) exists and must be resolved.

(5)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 1, 2,¹ 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,022,440 to Nordeen et al. in view of U.S. Patent No. 3,486,450 to Houle et al.

Regarding applicant claim 1, Nordeen et al. disclose an imaged laminate suitable for use in color proofing comprising (column 2, lines 28-32):

- (1) An imaged layer comprising a thermoplastic (column 6, lines 41-59);
- (2) A second thermoplastic layer (column 6, lines 60-65) disposed on the first thermoplastic layer with the image disposed there between; and
- (3) A support (substrate) layer disposed on the surface of the second thermoplastic layer opposite that upon which is disposed the first thermoplastic layer.

Although Nordeen et al. do not specifically disclose that the support layer, as per applicant claim 1, is clear. Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize a clear or transparent support (substrate) layer in the method of Nordeen et al. motivated by the fact that Nordeen et al. disclose that there exists no real limitation of the nature of the substrate - they disclose a variety of materials may be used such as polymeric films, paper, glass, cardboard, metal sheeting (column 7, lines 7-12) and furthermore by the fact that Houle et al., also drawn to color proof laminates, disclose that transparent color proof supports are known in the art (column 1, lines 42-46; column 2, lines 1-71).

Regarding applicant claim 4, Nordeen et al. disclose that the image may comprise a multi-colored imaged (column 3, lines 3-20).

Regarding applicant claim 5, Nordeen et al. disclose that the second thermoplastic layer has a thickness of from 2 to 10 μm (column 7, lines 3-6).

(6)

Claims 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (5), above, in further view of U.S. Patent No. 5,984,46 to Silverbrook.

¹ Although Nordeen et al. disclose, as per applicant claim 2, that the first imaged thermoplastic layer is disposed on the support and second thermoplastic layer by transfer from a first support (which is stripped after transfer), claim 2 has not been afforded any patentable weight as it forms no part of the actual imaged laminate (overlay) article.

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Although Nordeen et al., as combined in section (5), above, disclose that the image may comprise a multicolored image formed by, for example, ink-jet printing, they do not specifically disclose, as per applicant claim 3, that the image comprises monochrome images having a resolution, as per applicant claims 6 and 7, of between 1400 to 4000dpi and 1800 to 3000 dpi, respectively.

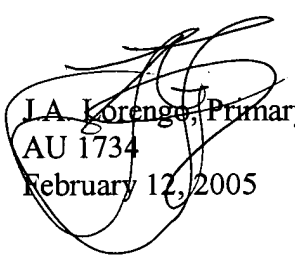
Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize monochrome images printed at the claimed image resolution motivated by the fact that Silverbrook et al., also drawn to methods for the formation ink-jet printed images, disclose that it is typical in the color proofing arts to form individual monochrome (YMCK) color separation films at resolutions of between 1800 and 3600dpi (column 28, lines 12-24).

(7)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J.A. Lorengo, Primary Examiner
AU 1734
February 12, 2005